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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,617	06/17/1999	YOSHIHIRO IDA	P18051	5530
7055	7590	02/22/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			GIBBS, HEATHER D	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/334,617	Applicant(s) IDA ET AL.	
	Examiner Heather D Gibbs	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>01/31/2005</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

Response to Amendment

1. The amendment filed on 09/08/2004 has been entered and made of record. Claims 24-32 are now pending.

Response to Arguments

2. Applicant's arguments with respect to claims 24-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 24-26,30 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi (JP 10-374412).

Considering claims 24, which is representative of claim 30, Takahashi discloses a server apparatus connected with a transmitting facsimile apparatus and a receiving facsimile apparatus via the Internet, the server apparatus comprising: a memory configured to store reception capabilities regarding a type of facsimile data that the receiving facsimile apparatus can receive, the reception capabilities being distinct from facsimile data

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(Paragraph 19); and a controller configured to receive facsimile data from the transmitting facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the reception capabilities stored in the memory, and to transmit the transformed facsimile data to the receiving facsimile apparatus (Paragraph 14).

Regarding claims 25-26, Takahashi teaches wherein a reception capability regarding a type of facsimile data is a type of file data that the receiving facsimile apparatus can receive and wherein the type of file data is at least one of MH, MR, MMR, and JPEG (Abstract).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 27-28,31 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant et al (US 5,581,366).

Regarding claim 27, Merchant teaches a server apparatus connected with a facsimile via the Internet, the server apparatus comprising: a memory configured to store reception capabilities regarding a type of facsimile data that the facsimile apparatus can receive, the reception capabilities being distinct from facsimile data (Col 4 Lines 1-28); and a controller configured to receive, from the facsimile apparatus, an e-mail with a predetermined address, the e-mail indicating the reception capabilities of the facsimile apparatus to be stored in the memory, the controller being further configured to store the

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reception capabilities of the facsimile apparatus in the memory (Col 5 Lines 48-Col 6 Lines 1-5).

Considering claim 28, Merchant teaches wherein the controller determines whether or not the e-mail address is the predetermined address, and in response to a determination that the e-mail address is the predetermined address, stores the capabilities of the facsimile apparatus in the memory (Col 5 Lines 37-Col 6 Lines 1-5).

Considering claim 31, Merchant discloses wherein the predetermined address indicates that the e-mail contains data regarding the reception capabilities of the facsimile apparatus to be stored in the memory of the server apparatus (Col 4 Lines 16-28).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant et al (US 5,581,366) in view of Hochman (US 5,838,685).

9. Regarding claim 29, Merchant teaches an internet facsimile apparatus connected with a server apparatus via the Internet, the Internet facsimile apparatus comprising: a controller configured to transmit to the server by e-mail, reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive, the transmitted e-mail having a predetermined address, the e-mail indicating the reception capabilities of the

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Internet facsimile apparatus to be stored in the server apparatus (Col 4 Lines 1-28; Col 5 Lines 48- Col 6 Lines 6).

Merchant does not disclose expressly a communicator configured to communicate with a server apparatus via the Internet.

Hochman discloses a communicator configured to communicate with a server apparatus via the Internet (Col 4 Lines 25-36).

Merchant & Hochman are combinable because they are both facsimile.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Hochman with Merchant.

The suggestion/motivation for doing so would have been to communicate via the Internet.

Therefore, it would have been obvious to combine Merchant with Hochman to obtain the invention as specified in claim 29.

Considering claim 32, Merchant teaches wherein the predetermined address indicates that the e-mail contains data regarding the reception capabilities of the Internet facsimile apparatus to be stored in the server apparatus (Fig 6; Col 4 Lines 10-28).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until


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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Heather D Gibbs
Examiner
Art Unit 2622

hdg